

REMARKS

I. Introduction

This paper is filed in response to the non-final Office Action mailed October 28, 2008. Claims 3-15 are amended. After entry of the present amendment, claims 3-16 and 18-20 are pending in the present application.

Applicant traverses each of the rejections in the Office Action. Reconsideration and allowance of all pending claims is respectfully requested in view of the remarks below.

II. Rejection under 35 U.S.C. § 112

The Office Action rejected claims 3-16 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter. Specifically, the Office Action contended that the words “being” in claims 3 and 15 and the words “to be,” “can be,” and “when” in claim 15 “causes the claims to be broad and indefinite.” Office Action, pp. 2-3. Although the Applicant disagrees that the claims are “broad and indefinite” with these words included, claims 3 and 15 are amended to remove the words identified by the Office Action. Withdrawal of the rejection is kindly requested.

III. Rejection under 35 U.S.C. § 101

The Office Action rejected claims 3 – 16 under 35 U.S.C. § 101 as being directed to non-statutory subject matter. The Office Action also suggested amendments to claims 3 and 15 that would overcome the rejection. Claims 3 and 15 are amended per the suggestion by the Office Action. Applicants submit that after entry of the amendments, claims 3-16 overcome the rejection under Section 101. Withdrawal of the rejection is kindly requested.

IV. Rejection of Claims 3, 15-16, and 18 under 35 U.S.C. § 102(e)

The Office Action rejected claims 3, 15-16, and 18 under 35 U.S.C. § 102(e) as being allegedly anticipated by U.S. Patent No. 6,539,387 to Oren, *et al.* (“Oren”). Applicant respectfully traverses this rejection and requests its reconsideration and withdrawal because Oren fails to disclose or suggest each claimed element.

To sustain a rejection under 35 U.S.C. § 102, each element as set forth in a claim must be expressly or inherently described in a single prior art reference. *See* MPEP § 2131. Oren does not describe each element set forth in claims 3, 15-16, and 18 and, thus, the rejection should be withdrawn. For example, Oren fails to disclose or suggest, “linking the sub-portions of each of the plurality of portions of the database to one another in a predetermined sequential arrangement,” as recited in claim 3. Claims 15-16 and 18 each recite similar elements.

As explained in its Abstract, Oren discloses a structured-focused hierarchical hypertext data structure in which hypertext nodes store identifying information about source and target documents and their relative positions in the data structure. The documents or pages in the data structure are organized in a hierarchical fashion wherein links are made between pages at different levels or pages at the same level. *See e.g.*, Oren, col. 4, lines 45-50. The hierarchical data structure is organized as chapters, one or more levels of sub-chapters and pages within the chapters or sub-chapters. *See e.g., Id.* at col. 5, lines 1-11. The pages in the Oren data structure are each linked to one or more other pages in the data structure. *See e.g., Id.* Oren does not, however, disclose that the pages, whether on one level or at different levels, are arranged in any sequential arrangement, nor do the navigation links provided by Oren enforce sequential navigation.

Thus, the hypertext system envisaged in Oren serves primarily as a database search tool for facilitating searches and navigation through a large multimedia database. In contrast, the present invention serves primarily as a manual authoring tool providing a database comprising a plurality of portions in which information is stored, wherein each of the portions is sub-divided into a plurality of sub-portions. The database is structured such that the sub-portions of each portion are linked to one another in a linear sequential arrangement wherein each succeeding sub-portion contains further information on a topic thereby providing a linear navigation path. The sequential navigation links are established in advance by linking the sub-portions.

The navigation links between the sub-portions are established between the sub-portions prior to population of the sub-portions with data and, as such, are not data-driven. More specifically, the navigation links are not data dependent as is the case with the hypertext links of the data structure disclosed in Oren.

In the present invention, navigation from one sub-portion to another sub-portion follows a predetermined sequence wherein only one default navigation link is provided between a particular sub-portion and the preceding or succeeding sub-portion in the sequence. Thus, the default navigation links of the present invention provide for a single default navigation link between a sub-portion and one preceding sub-portion only and a further single navigation link between the sub-portion and one succeeding sub-portion only.

The data structure of the present invention as claimed thus provides for the information stored in sub-portions to be accessed in a predetermined linear sequential arrangement which provides for natural sequential amplification of the information as each succeeding sub-portion is accessed by the user.

In contrast, navigation in Oren is not in a linear sequential arrangement; navigation in Oren occurs in any direction between linked pages – from a “child” page to a “parent” page or vice versa or simply between two linked pages on the same level within the data structure, for example. Because Oren does not enforce any sequential navigation of the pages in the data structure, Oren fails to disclose or suggest “linking the sub-portions of each of the plurality of portions of the database to

one another in a predetermined sequential arrangement.” Accordingly, Applicant submits that pending claims 3, 15-16, and 18 are patentable over Oren and the other art of record. Withdrawal of the rejection and allowance of claims 3, 15-16, and 18 is kindly requested.

V. Rejections under 35 U.S.C. § 103(a)

A. Claims 4-7, 14, and 19- 20

The Office Action rejected claims 4-7, 14, and 19-20 under 35 U.S.C. § 103(a) as being allegedly obvious over Oren in view of U.S. Publication No. 2001/0047358 to Flinn, *et al.* (“Flinn”). Claims 4-7 and 14 depend from and further limit claim 3. Claims 19-20 depend from and further limit claim 18. Reasons for allowing claims 3 and 18 are provided above. For at least those same reasons, claims 4-7, 14, and 19-20 are also patentable. Withdrawal of the rejection and allowance of claims 4-7, 14, and 19-20 is kindly requested.

Claims 4-7, 14, and 19-20 are patentable for other reasons. For example, the Office Action failed to establish *prima facie* obviousness because its alleged reason why one of ordinary skill in the art would have combined Oren with Flinn is deficient. The Office Action’s alleged reason why one of ordinary skill in the art would combine Oren and Flinn appears to be “some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention.” The Office Action’s mere conclusory statements that there is some teaching, suggestion, or

motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or combine prior art reference teachings are impermissible. *See In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)("[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.")

MPEP Section 2143(G) identifies the findings Office personnel must articulate to reject claims on the basis of some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or combine prior art reference teachings. The findings include the following:

- (1) a finding that there was some teaching, suggestion, or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings;
- (2) a finding that there was a reasonable expectation of success;
- and
- (3) whatever additional findings based on the *Graham* factual inquiries may be necessary, in view of the facts of the case under consideration.

The Office Action failed to articulate findings for at least (1) and (2) above or merely offered conclusory statements that use impermissible hindsight basis reasoning

for these and other required findings. For example, the alleged reason offered by the Office Action on page 13 purports that it would have been obvious to practice the teachings of Flinn. This is not a reason for combining Oren with Flinn; it merely uses hindsight bias to contend it would have been obvious to practice the teachings of Flinn.

Accordingly, the Applicant submits that the Office Action failed to establish *prima facie* obviousness and requests withdrawal of the rejections. Should the Office still opine, after reviewing the present response, that one or more of the pending claims are obvious, a full and clear statement of the grounds on which these claims are rejected pursuant to MPEP Section 707.07(d) is requested so that any rejection is clearly articulated to provide the Applicant with the opportunity to provide evidence of patentability or otherwise reply completely at the earliest opportunity. *See* 35 U.S.C. § 132; MPEP § 706.

B. Claims 8-11

The Office Action rejected claims 8-11 under 35 U.S.C. § 103(a) as being allegedly obvious over Oren in view of Flinn and U.S. Patent No. 6,714,215 to Flora, *et al.* (“Flora”) Claims 8-11 depend from and further limit claim 3, for which reasons for allowance are provided above. Applicant submits that claims 8-11 are patentable for at least those same reasons. Withdrawal of the reject is kindly requested.

Furthermore, claims 8-11 are patentable for other reasons. Like the rejection of claims 4-7, 14, and 19-20, the Office Action failed to establish *prima facie*

obviousness because its alleged reason for combining Oren, Flinn, and Flora is deficient. The alleged reason offered by the Office Action merely states that it would have been obvious to practice the teachings of Flora. *See* Office Action, p. 15. This is not a reason why one of ordinary skill in the art would have combined Oren, Flinn, and Flora. Instead, it uses impermissible hindsight bias to allege one would have practiced the teachings of Flora. The Applicant respectfully directs the Office to the required findings identified in Section V(A) of the present response and MPEP Section 2143 that the Office Action failed to show. For example, the statement fails to identify any reasonable expectation of success in combining Oren, Flinn, and Flora. Withdrawal of the rejection is requested for this additional reason.

C. Claims 12-13

The Office Action rejected claims 12-13 under 35 U.S.C. § 103(a) as being allegedly obvious over the following four references:

1. Oren;
2. Flinn;
3. Flora; and
4. U.S. Patent No. 5,761,436 to Nielsen (“Nielsen”).

Each of claims 12-13 depend from and further limit claim 3, for which reasons for allowance are provided above. For at least the same reasons, Applicant submits claims 12-13 are patentable in view of the cited references and requests allowance of claims 12-13.

Claims 12-13 are patentable for the additional reason that the Office Action failed to establish *prima facie* obviousness. As with its other Section 103 rejections, the Office Action failed to articulate a sufficient reason why one of ordinary skill in the art would have combined these four references together. Instead, the Office Action merely stated a reason that appears to contend that it would have been obvious to practice the teachings of Nielsen, even assuming the interpretation by the Office Action of Nielsen is correct, which the Applicant does not concede. *See* Office Action, p. 17. Practicing the teachings of a references is not a reason for combining the reference with the teachings of other references. The Applicant respectfully directs the Office to the required findings identified in Section V(A) of the present response and MPEP Section 2143 that the Office Action failed to show. For example, the statement fails to identify any reasonable expectation of success in combining Oren, Flinn, Flora, and Nielsen. Withdrawal of the rejection is requested for this additional reason.

CONCLUSION

The undersigned respectfully submits that all pending claims are in a condition for allowance. If any additional fees are due for this application, the fees may be charged to Deposit Account number 11-0855. If there are any matters that can be addressed by telephone, the Examiner is urged to contact the undersigned attorney at 404 745-2520.

Respectfully submitted,
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